

Remarks

Claims 180-304 are pending in the subject application. By this Amendment, Applicants have canceled claims 189, 229, 247-248, 250-257, 287-294 and 301, amended claims 180, 181, 276 and 302-304, and added new claims 305-324 (which correspond to species elected in response to Office Action of August 10, 2004). Claims 180-184, 186-188, 190-193, 198-200, 204, 207, 228, 230-235, 246, 249, 258, 276, 286, 295, 299, 300 and 302-324 read on the elected invention and are before the Examiner. Claims 185, 194-197, 201-203, 205, 206, 208-227, 236-245, 259-275, 277-285 and 296-298 stand withdrawn from consideration as being drawn to a non-elected invention. Support for the new claims can be found throughout the subject specification and in the claims as originally filed (see, for example, pages 36-71 of the originally filed specification and the original claims). Entry and consideration of the amendments presented herein is respectfully requested. Favorable consideration of the pending claims is respectfully requested.

At the outset, Applicants note that the Patent Office has afforded the priority date of January 8, 2001. Applicants traverse. The Office Action argues that support for an automated dispensing apparatus “directed by a work list generated by formulations software, said work list allowing a file to be used as a process command rather than discrete programmed steps” is not found in all provisional patent applications to which priority is claimed. Applicants submit that such priority is found in, at least, provisional patent application 60/221,539, filed July 28, 2000 at page 18, lines 13-25. The Office Action also argues that support for “sealing” the samples and the use of a “septum”, syringe, needle and/or septum piercing method steps is not supported by a variety of the applications. Again, Applicants respectfully submit that such limitations enjoy the benefit of, at least, provisional patent application 60/221,539, filed July 28, 2000 at page 11, lines 20-33 and page 19, lines 3-15. Further, and in addition to the locations identified by the Patent Office as providing support for the limitations related to “Raman spectroscopy” and “integrated modules or workstations”, Applicants submit that the ‘539 patent application also provides support for such limitations (see, for example, page 16, lines 10-17; page 50, line 30 through page 51, line 9; page 19, lines 16-19; page 38, line 1 through page 40, line 22). The Office Action also argues that no support for the term “evaporating” can be found in the priority documents. Applicants submit that support for the term can be found in, at least, provisional patent application 60/221,539, filed July 28, 2000 at page 10, lines 33-35; page

15, lines 10-14; page 19, lines 27-30; page 21, lines 14-20; and page 39, line 8 though page 40, line 22. Applicants further submit that support for the phrase “metal support plate” can also be found in provisional patent application 60/221,539, filed July 28, 2000 at page 11, lines 20-21. Applicants note that the Office Action argues that none of the priority applications provide adequate written support for each of the limitations recited within the claims. Applicants traverse this finding and respectfully submit that support for the currently claimed method can be found in, at least, provisional patent application 60/221,539, filed July 28, 2000 at page 6, line 23 through page 14, line 29 and page 15, line 21 through page 54, line 32 and that the benefit of, at least, that application should be granted by the Patent Office.

Claim 186 is objected to under 37 CFR §1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 229 is objected to under 37 CFR §1.75(c), as being a substantial duplicate of claim 188. These objections are now moot in view of the cancellation of the claims.

Claims 180-184, 186-193, 198-200, 204, 207, 228-235, 246, 249, 258, 286, 295 and 299-304 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as their invention. Claim 198 was rejected on the basis that the phrase “said grouped samples” lack antecedent basis in claim 180. Applicants respectfully submit that this issue is moot in view of the amendment of claim 180 to provide antecedent basis for this phrase. Claims 180 and 302-304 have been rejected on the basis that the term “informatics” is vague and indefinite. Applicants respectfully submit that this issue is now moot in view of the cancellation of the term from the claims. Claim 181 has been rejected on the basis that the phrase “further analysis” is indefinite. Applicants respectfully submit that this issue is moot in view of the amendments made to the claim. Finally, claim 301 has been rejected on the basis that the term “machine vision technology” is indefinite. Applicants have canceled this claim as the claim on which it depends fails to provide antecedent basis for the claim. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. §112, second paragraph, is respectfully requested.

Claims 180-184, 186-193, 198-200, 204, 207, 228-235, 246, 249, 258, 286, 295 and 299-304 are rejected under 35 U.S.C. §103(a) as being unpatentable over Galakatos *et al.* (WO 00/59627), Merritt (Merritt, A.T. 1998 DDT, 3(11), 505-510) and Saneii *et al.* (U.S. Patent No. 5,746,982), Wang *et al.* (Wang, T. *et al. Rapid. Commun. Mass Spec.* 1998, 12, 1123-1129), and Newsam *et al.* (Newsam, J.M. *et al. Biotechnol and Bioengineering (Combinatorial Chemistry)* 1999, 61(4), 203-216)).

Applicants respectfully submit that Galakatos *et al.* is, at best, prior art that is available for this obviousness rejection under, possibly, 35 U.S.C. § 102(e) as the claims of this application enjoy the benefit of, at least provisional patent application 60/221,539, filed July 28, 2000 and Galakatos *et al.* published on October 12, 2000. As the Patent Office is aware, applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

In this instance, the cited reference, WO 00/59627 (Galakatos *et al.*) and the above-identified patent application were subject to an obligation of assignment to the same entity (Millennium Pharmaceuticals, Inc.) at the time the invention was made. Applicants submit, herewith, a Statement Establishing Common Ownership Or An Obligation Of Assignment To The Same Person, As Required By 35 U.S.C. 103(c) that disqualifies Galakatos *et al.* as prior art. Applicants further reserve the right to contest the possible priority dates of the Galakatos *et al.* publication. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

It should be understood that the amendments presented herein have been made solely to expedite prosecution of the subject application to completion and should not be construed as an indication of Applicants' agreement with or acquiescence in the Examiner's position. Applicants expressly reserve the right to pursue the invention(s) disclosed in the subject application, including any subject matter canceled or not pursued during prosecution of the subject application, in a related application.

In view of the foregoing remarks and amendments to the claims, Applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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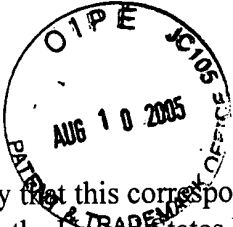
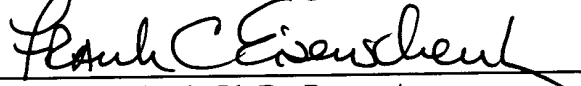
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Attachment: Statement Establishing Common Ownership Or An Obligation Of Assignment To
The Same Person, As Required By 35 U.S.C. 103(c)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
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Frank C. Eisenschenk, Ph.D., Patent Attorney

Examining Group 1639
Patent Application
Docket No. TPI-T200XC1
Serial No. 09/756,092

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner : Jon D. Epperson
Art Unit : 1639
Applicants : Michael J. Cima, Douglas Levinson, Anthony V. Lemmo, Nicholas Galakatos, David A. Putnam
Serial No. : 09/756,092
Filed : January 8, 2001
Conf. No. : 5650
For : High-Throughput Formation, Identification and Analysis of Diverse Solid Forms

MAIL STOP AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

STATEMENT ESTABLISHING COMMON OWNERSHIP OR AN OBLIGATION OF
ASSIGNMENT TO THE SAME PERSON, AS REQUIRED BY 35 U.S.C. 103(c)

Sir:

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. In this instance, the cited reference, WO 00/59627 (Galakatos *et al.*) and the above-

identified patent application were subject to an obligation of assignment to the same entity (Millennium Pharmaceuticals, Inc.) at the time the invention was made.

Respectfully submitted,



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